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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,234	09/25/2001	Jarett L. Rinaldi	42190P12122	7885

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Michael A Proksch  
Blankely Sokoloff Taylor & Zafman LLP  
12400 Willshire Boulevard  
7th Floor  
Los Angeles, CA 90025

EXAMINER

MITCHELL, JAMES M

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/965,234

Applicant(s)

RINALDI ET AL.

Examiner

James Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for "a plurality of light emitting diode die formed on the integrated circuit substrate..." recited in claim 1, Lines 3-4.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-23, 25-27 and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishinaga et al. (U.S 6,093,940).
5. Ishinaga (Fig 1,3A, 4) discloses a surface mount device light emitting diode package, comprising: an integrated circuit substrate (1;Col. 4, Lines 21-24;

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via metal embedded in substrate) attached to a printed circuit board (10), a plurality of LED comprising a first light emitting diode (2a) and a second light emitting diode (2b) supported by said circuit board housing and soldered (9) to the board, wherein said first and second LED are inherently coupled to the printed board via cathode and anode (20, 21 and 22) patterned into the housing (Fig 4, 4"; via bottom portion of housing surrounding LED); and a plurality of electrical terminals (7) extending on the outside of the integrated circuit substrate with contacts adapted for surface mounting, wherein first and second LED are stacked in a line, a line of LED die is adapted to form a right angle with respect to the circuit board (see Fig 4) when the package, a die inherently form a single wafer; further including a housing (1,6) with the plurality of LED supported by the housing; the package further comprising an inherent piece of long slender solid material, via portion of 6 between and on adjacent LED that reinforce the LED thus forming a reinforcing pin (via item 6 formed of multiple contiguous layers that form sections) wherein one of said plurality of contacts comprise a cathode contact and wherein another of said plurality of contacts comprise an anode contact, with reinforcing pin positioned between the cathode and anode (shown Fig 1, 3B, Col. 5, Lines 11-15).

6. With respect to produce by process claim "adjacent die from a single wafer", the prior art structure is the same as the claimed invention. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the

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product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishinaga as applied to claim 21 and 25.

10. Ishinaga does not appear to explicitly disclose that an array of die having at least two rows and two columns.

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11. However, the prior art discloses the claimed invention except for a showing that the LED has an array of die having at least two rows and two columns or a third and fourth LED forming a two by two matrix. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a LED with an array of die having at least two rows and two columns and to form a third and fourth LED, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *In re Harza*, 124 U.S.P.Q 378 (CCPA 1960).

### ***Response to Arguments***

12. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. However examiner to expedite prosecution of the application, examiner has addressed some arguments that applicant may still deem relevant.

13. Applicant contends that because Ishinaga teaches two colors that it teaches away from dies form the same wafer. Absent evidence, applicant has not established a prima facie case that dies from a single wafer cannot have different colors; mere conjectures don't establish validity (See US 20020030444, LEDs of same wafer that emit different color). Furthermore the broad scope of being "adjacent die from a single wafer," (i.e. silicon or sapphire etc.) does not impart a structural limitation except that the LED has a substrate.

14. Lastly, applicant indicates that none of the advantages of the present invention are in Ishinaga, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior

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art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### **Conclusion**

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

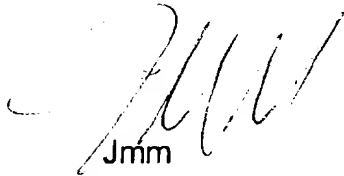
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (703) 305-0244. The examiner can normally be reached on M-F 10:30-8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (703) 308-1233. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Jmm



DAVID E. GRAYBILL  
PRIMARY EXAMINER